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09/289,000 02/25/97 BLATT G 16683-1-2

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

QM22/0226

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EXAMINER

3738
ART UNIT | PAPER NUMBER

02/26/01

21

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/289,000	Blatt
Examiner	**Group Art Unit**
Paul Prebilic	3738

☒ Responsive to communication(s) filed on *Jan 8, 2001* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-6, 8-10, and 24-26* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-6, 8-10, and 24-26* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 8, 2001 has been entered.

Claim Rejections Based Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4-6, 8-10, and 24-26 are rejected under 35 U.S.C. 102(b) as anticipated by Cohen (US 5,207,712) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cohen (US 5,207,712) alone. Cohen (US 5,207,712) anticipates the claim language wherein the resection of bone ends or the holes drilled into the bone ends expose the cancellous bone surface and the solid sphere and rods allow both for the joint to flex and extend after implantation (see Col. 4, lines 38

and 39) and the ball (4) provides a sliding surface for the joint ends; see the whole document, especially Col. 3, lines 18-20; Col. 4, lines 3-39 and Figures 1-3 and 8-11.

Alternatively, one could view the ball (4) as not providing a sliding surface because it is not explicitly stated as providing such. However, the Examiner posits that one viewing this embodiment would be led to the conclusion that the ball (4) obviously functions as a stop and sliding surface for the resected bone ends because the joint flexes and extends around the ball surface; see column 4, lines 38-39.

With regard to claims 8 and 9, Applicant is directed to Figure 1 and especially Figure 2 for claim 8.

With regard to claim 24 specifically, the Examiner posits that a period of 6 to 7 months would be sufficient to allow all the natural processes of the permitting step as claimed to take place; see Col. 2, lines 45-48.

With regard to claims 4, 10, and 25 specifically, the estimating step as claimed is inherently or implicitly present in Cohen who makes his device for a particular joint type so that as much regrowth between the joints can take place.

Claims 2 and 3 are rejected under 35 U.S.C. § 103 as being unpatentable over Cohen (US 5,207,712) in view of Delcommune et al (US 5,007,939). Cohen meets the claim language except for the use of lactic acid polymer or copolymer as claimed. Delcommune et al, however, teaches that it has been known to use lactic acid polymer or copolymer for resorbable bone repair devices. Hence, it is the Examiner's position that it would have been obvious to one of ordinary skill in the

art to use lactic acid polymer or copolymer in place of in addition to the polymer of Cohen for the same reasons that Delcommune et al uses the same and in order to further reduce the cost of making the device.

Response to Arguments

Applicant's arguments filed January 8, 2001 have been fully considered and are persuasive with respect to the 35 USC 112 rejections but not with regard to the prior art rejections.

In response to the traversal of the 35 USC 112 rejections, the Examiner reviewed Applicant's arguments as they pertain to the rejection and found that there was implicit support for this in the specification on page 7, lines 8-13. However, the Examiner posits that such essential subject matter should have explicit support from the disclosure. For this reason, the Examiner hereby respectfully requests amending the specification to give explicit antecedent support to this claimed subject matter so that the claimed subject matter has antecedent basis from the disclosure.

With regard to the argument that sliding motion is prevented by Cohen, the Examiner respectfully disagrees and takes the position that since the joint can flex and extend with the implant in place (see Col. 4, lines 38-39) that sliding on the ball (4) face would occur. Furthermore, the claims still do not require lateral sliding motion between the joint ends as apparently suggested by Applicant's arguments only sliding motion between the face(s) and the joint end(s) is required. For this reason, the claim language is fully met in this regard.

Furthermore, Cohen states that the joint can flex and extend once the implant is located in the joint, and thus, the rods cannot be rigid; see column 4, lines 38-39 of Cohen.

In particular, Applicant argues that this flexion and extension motion possibly refers to an adjacent joint and cannot refer to the joint containing an implant. However, the Examiner posits that "the joint" must refer to the joint containing an implant because no other joint is the topic of discussion in the context of the disclosure text.

In response to the argument that formation of fibroblast and fibrocartilage is conditioned on joint motion, the Examiner asserts that this process would also occur in the Cohen healing process because joint motion is also provided thereby as pointed out above. Applicant may have discovered a natural healing process which occurs with the Cohen implant when the joint is mobile during healing. However, this process, since natural, is not patentable and would inherently occur in the Cohen invention even though Cohen may not have been aware of it.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.

Paul Prebilic
Primary Examiner
Art Unit 3738